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EXAMINER

CHEUNG, MARY DA ZHI WANG

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3621

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**BEFORE THE BOARD OF PATENT APPEALS
AND INTERFERENCES**

Application Number: 09/423,511
Filing Date: November 10, 1999
Appellant(s): SJOBLUM, HANS

Timothy Platt
For Appellant

EXAMINER'S ANSWER

This is in response to the appeal brief filed December 16, 2004.

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(1) *Real Party in Interest*

A statement identifying the real party in interest is contained in the brief.

(2) *Related Appeals and Interferences*

A statement identifying the related appeals and interferences which will directly affect or be directly affected by or have a bearing on the decision in the pending appeal is contained in the brief.

(3) *Status of Claims*

The statement of the status of the claims contained in the brief is correct. However, the appellant does not state what claims to be appealed. For clarification, the status of the claims as following:

This appeal involves claims 1-3 and 6-29.

Claims 4-5 have been canceled.

(4) *Status of Amendments After Final*

The appellant's statement of the status of amendments after final rejection contained in the brief is correct. For further clarification, the amendment after final rejection filed on September 2, 2004 has been entered.

(5) *Summary of Invention*

The summary of invention contained in the brief is correct.

(6) *Issues*

The appellant's statement of the issues in the brief is correct.

(7) *Grouping of Claims*

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The rejection of claims 1-3 and 6-29 stand or fall together because appellant's brief does not include a statement that this grouping of claims does not stand or fall together and reasons in support thereof. See 37 CFR 1.192(c)(7).

(8) Claims Appealed

The copy of the appealed claims contained in the Appendix to the brief is correct.

(9) Prior Art of Record

6,038,551

BARLOW et al.

3-2000

(10) Grounds of Rejection

Due to enter of the after final amendment, examiner has revised the rejections to reflect the change of the claims. The following ground(s) of rejection are applicable to the appealed claims:

Claim Rejections - 35 USC § 102

1. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(e) the invention was described in (1) an application for patent, published under section 122(b), by another filed in the United States before the invention by the applicant for patent or (2) a patent granted on an application for patent by another filed in the United States before the invention by the applicant for patent, except that an international application filed under the treaty defined in section 351(a) shall have the effects for purposes of this subsection of an application filed in the United States only if the international application designated the United States and was published under Article 21(2) of such treaty in the English language.

2. Claims 1-3, 6-9, 11-13, 15-18, 21-23 and 25-29 are rejected under 35 U.S.C. 102(e) as being anticipated by Barlow et al., U. S. Patent 6,038,551.

As to claim 1, Barlow teaches a method for performing electronic transactions via a communications network, in which a sender of transaction messages is assigned a

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smart card with an associated unique identity and a private key stored in the card in a protected manner, and in which an associated public key is kept generally available, characterised in that in connection with an electronic transaction under the sender's own control, preferably through his own input of message information, the sender, independently of any connection to a communication network and without computer dialogue with a receiver, creates, on the basis of entered transaction information, a transaction message, which contains information necessary for the transaction, the transaction message being created in the smart card with the aid of software previously stored in the smart card, and, in his smart card, provides the created transaction message with his digital signature while using his own private key for subsequent output and transmission of the transaction message (column 13 lines 20-39 and column 14 lines 5 – column 15 line 10 and Figs. 3, 5, 7-10; *specifically, at column 14 line 62 – column 15 line 10, Barlow teaches the user uses the IC card to make an offline purchase, such as a purchase from a vending machine; that is an example of creating a transaction message by a sender without communications network dialogue*).

As to claim 2, Barlow teaches characterised in that the transaction message contains information on sender, receiver, amount and preferably a transaction serial number (column 14 lines 5-61 and Figs. 3, 5, 7-10).

As to claim 3, Barlow teaches the transaction message is created off-line (column 14 line 61 – column 15 line 10).

As to claim 6, Barlow teaches characterised in that the transaction message is created with the aid of software inserted in the smart card in advance and preferably

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also sender information inserted in the card in advance (column 14 lines 5-61 and Figs. 3, 5, 7-10).

As to claim 7, Barlow teaches characterised in that information required for the transaction message is input with the aid of input means arranged on the smart card, the card preferably being a so-called advanced smart card (column 14 lines 5-61 and Figs. 3, 5, 7-10).

As to claim 8, Barlow teaches characterised in that information necessary for the transaction message is input with the aid of a protected card terminal (column 15 lines 47-52 and Figs. 3-5).

As to claim 9, Barlow teaches characterised in that information necessary for the transaction message is input with the aid of a separate card communication unit, the latter preferably also being a card activator (Figs. 1-2).

As to claim 11, Barlow teaches characterised in that the transaction message contains sender information in the form of at least one of the following pieces of information: a card number, a cash card number, a charge card number, a credit card number, an account number, an invoice number and an ID number (column 14 lines 5-61 and Figs. 3, 5, 7-10).

As to claim 12, Barlow teaches characterised in that the transaction message contains receiver information in the form of at least one of the following pieces of information: a card number, a cash card number, a charge card number, a credit card number, an account number, an invoice number and an ID number (column 14 lines 5-61 and Figs. 3, 5, 7-12).

As to claim 13, Barlow teaches characterised in that the signed transaction message is sent to a card or account administrator regarding the sender or receiver, that the digital signature of the transaction message is authenticated by using the public key, which is assigned to the one who is identified as sender by the transmitted transaction message, and that in case of authenticity, the receiver is credited with the transaction amount by a clearing process (column 14 lines 5-61 and Figs. 3, 5, 7-10).

As to claim 15, Barlow teaches characterised in that the signed transaction message is encrypted by using a public key belonging to the addressee, to whom the transaction message is sent, that the encrypted, signed transaction message is sent to the addressee, that the addressee by using his private key decrypts the signed transaction message, that the digital signature of the transaction message is authenticated by using the public key which is assigned to the one who is identified as sender by the transmitted transaction message, and that the receiver, in case of authenticity, is credited with the transaction amount by a clearing process (column 14 lines 5-61 and Figs. 3, 5, 7-12).

As to claim 16, Barlow teaches characterised in that the addressee is the receiver, that the receiver, after decryption, sends the signed transaction message to a card or account administrator, whereupon said authentication takes place (column 14 lines 5-61 and Figs. 3, 5, 7-12).

As to claim 17, Barlow teaches characterised in that the signed transaction message is encrypted by using the sender's public key and is provided with sender information and is then sent to a card or account administrator, who has the sender's

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private key and who preferably has issued the user's smart card, that said administrator decrypts the received encrypted message by using said private key, that authentication of the digital signature of the decrypted transaction message takes place by using the public key, which is assigned to the one who is identified as sender by the transmitted transaction message, and that the receiver, in case of authenticity, is credited with the transaction amount by a clearing process (column 14 lines 5-61 and Figs. 3, 5, 7-12).

As to claim 18, Barlow teaches characterised in that the signed transaction message is sent non-encrypted, especially via a public communications network, such as the Internet or a telecommunications network (column 15 lines 11-17).

Claims 21, 23 and 26 are rejected for the similar reasons as claims 1 and 13.

Claims 22 and 28 are rejected for the similar reason as claim 7.

Claim 25 is rejected for the similar reason as claim 9.

Claims 27 and 29 are rejected for the similar reason as claims 3-4.

Claim Rejections - 35 USC § 103

3. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

4. Claim 14 is rejected under 35 U.S.C. 103(a) as being unpatentable over Barlow et al., U. S. Patent 6,038,551.

As to claim 14, Barlow teaches the signed transaction message is first sent to the receiver (column 14 lines 5-61 and Figs. 3, 5, 7-10). Barlow does not specifically teach

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optionally forwards the signed transaction message to said card or account administrator. It would have been obvious to one of ordinary skill in the art to allow the system of Barlow to include the feature of forwarding the signed transaction message to his/her smart card or account administrator so that the transaction can be better tracked.

5. Claims 10, 19-20 and 24 are rejected under 35 U.S.C. 103(a) as being unpatentable over Barlow et al., U. S. Patent 6,038,551 in view of Heinonen et al., U. S. Patent 5,887,266.

As to claims 10, 19-20 and 24, Barlow does not specifically teach the telecommunication unit is a mobile telecommunication unit such as mobile phone. However, Heinonen teaches a mobile telecommunications unit such as a mobile phone controlled by the smart card and SMS service is used for communicating data message (column 1 lines 11-37 and column 2 lines 17-42 and column 3 lines 1-10 and Fig. 6). It would have been obvious to one of ordinary skill in the art at the time the invention was made to allow the telecommunication unit of Barlow to include features as taught by Heinonen so that user can remotely transmit or access messages.

(11) Response to Argument

In regards to independent claim 1, appellant argues that Barlow does not teach a sender sends a message independently of any connection to a communications network and without computer dialogue with a receiver, and digitally signing the transaction message. Examiner respectfully disagrees. First, **these limitations are optional**, as recited in the claim, "**preferably** through his own input of message

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information, the sender, independently of any connection to a communications network and without computer dialogue with a receiver, creates, on the basis of entered transaction information, a transaction message, ... provides the created transaction message with his digital signature...". Secondly, Barlow states "the vending machine is an example of an offline computer, one that is not attached to a back end network" (column 14 lines 65-66). Barlow teaches using the smart card to transact messages to the vending machine (column 14 line 59 – column 15 line 5), which corresponds to the limitation sending transaction messages that is independently of any connection to a communications network and without computer dialogue with a receiver. Furthermore, Barlow teaches digitally signing the transact message by allowing the sending enter a passcode or other security protocol (column 14 lines 12-42 and column 15 lines 3-10).

In regards to independent claims 21, 23 and 26, appellant **does not** specifically present arguments that Barlow lack of teaching the claimed limitations. Examiner believes that Barlow teaches the claimed limitations, in particular at column 13 lines 20-39 and column 14 lines 5-58, Barlow teaches using a smart card to carrying out electronic transactions, storing card identification information (i.e. passcodes), private key, asymmetrical algorithm, transaction messages, etc. into the card.

The arguments for all other claims are based on their respective independent claims; thus, the arguments are reversed on the same basis as discussed above.

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For the above reasons, it is believed that the rejections should be sustained.

Respectfully submitted,

Mary Cheung
February 28, 2005



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